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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Appellant(s): MICHAEL McHALE, GEORGE NICHTULA, CHRISTINE L.
CORRIVEAU, WILLIAM J. WOKAS

Maxwell J. Petersen
For Appellant

JUL 09 1996

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal
filed 02/26/96.

(1) Real Party in Interest

A statement identifying the real party in interest is
contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and
interferences which will directly affect or be directly affected
by or have a bearing on the decision in the pending appeal is
contained in the brief.

Art Unit: 1302

(3) Status of claims.

The statement of the status of claims contained in the brief is correct. It is noted that applicants' broadly sweeping statement that the non-elected claims "would be allowable if the base claims are allowed" is considered inaccurate. According MPEP § 806.04(h):

Where, however, an applicant optionally files another national application with claims to a different species or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be a close investigation to determine the presence or absence of patentable difference. See M.P.E.P. §§ 804.01 and 804.02.

(4) Status of Amendments After Final.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because in the second paragraph, on page 3, applicants assert that "only the first chewing gum needs to have structural integrity", and, even in view of the language that follows this passage, the said passage is considered to present an aspect that is not disclosed in the specification.

Further, applicants' summary of the invention discusses 1) the prior processes for making chewing gum and 2) the process of producing the claimed products and, as stated in

Art Unit: 1302

M.P.E.P. § 1206(5), the summary should consist of a "concise explanation of the invention defined in the claims" (emphasis added). Therefore, the discussion of the process, which starts at the first full sentence of page 3, and continues to the end of the summary, is considered not to be a summary of the invention.

(6) Issues.

Appellant's brief presents arguments relating to whether the restriction requirement as to species should be withdrawn. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See M.P.E.P. §§ 1002 and 1201.

Because the previous issue relates to petitionable subject matter the issue of whether the withdrawn species should be allowed over the prior art is also considered to be an improper issue for appeal. It is noted at this time that any and all language directed to the discussion of these issues will not be dealt with.

Appellants' remaining issue, i.e., the 35 USC § 103 rejection, in the brief is correct.

Art Unit: 1302

(7) Grouping of Claims

Appellants' brief includes a statement that claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellants' Group A contains the limitation of the gums' pattern be in an undulating design and this is the species which Appellants elected for the Examiner to prosecute. The fact that Groups B and C have this same limitation is therefore inconsequential.

Appellants' Group B is not considered to be distinct from Group C because in view of the specification the claimed products are the same. Specifically, according to the claimed process by imbedding the second mass into the first mass it is inherent that the second mass will not be visible from the bottom of the first mass in light of the fact that the specification fails to disclose how the second mass could be smashed down through the first mass so as to be visible from the bottom.

(8) Claims Appealed

A substantially correct copy of appealed claims 1-6, 8, 15-19, 21, 28, 51-54 and 56 appears on pages 1 to 6 of the Appendix to the appellant's brief. The minor errors are as

Art Unit: 1302

follows: In Claim 4, the phrase --width of-- should be inserted before the phrase "first mass".

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,971,806 CHERUKURI ET AL. 11-1990

DE 35 16 85⁷ A1 LORENZ 11-1985

(10) Grounds of Rejection

Claims 1 to 6, 8, 15 to 19, 21, 28, 51 to 54 and 56 are rejected under 35 U.S.C. § 103 as being unpatentable over Lorenz (D.E. Pat. No. 3,516,852) or Cherukuri et al. (U.S. Pat. No. 4,971,806) in view of Lorenz.

Lorenz discloses the use of a multichannel chewing gum extruder to produce differently designed chewing gums with cross sections as seen in Figure 7. The patent "is based on the problem of offering a very practical extruder with a high output to manufacture multicolor compound products without theoretically limiting the number of colors or shapes." (Pages 3 to 4 of translation). Lorenz states that "the multichannel extruder [is] described for a three-color extruder" and that the "technology used is suitable for more colors" and that the "only limitation is a practical one" (page 5, lines 5 to 8).

Art Unit: 1302

When viewing the cross sections of the chewing gums in Figure 7 it is seen that the six cross sections on the left hand side of the Figure are square or what could be broadly considered "sheeted" with a top and bottom surface. As stated above the gums are multicolored. When viewing Figure 7, the fifth and sixth square gums are considered to most closely fit applicants' instant invention. A first mass (considered to be the majority of the gum's cross section) is formed in a "generally flat sheet" and has a smaller second mass of a different color imbedded into the first mass.

With respect to the first mass, as compared to the second mass, it is only visible from the bottom. Further, a third mass, which is distinct and separate from the first and second masses (and possibly even a different color), is visible from the bottom. Therefore, it is considered that, Appellants' claim limitation, i.e., that "the first mass only is visible from the bottom surface of the chewing gum product", is met by the disclosure of Lorenz because the claims do not exclude other masses, i.e. a third mass from being visible from the bottom. Specifically, the claim language is interpreted as requiring only first mass is visible from the bottom rather than both the first and second masses.

Lorenz is not relied on to teach a process of how to make the claimed product or the exact design of the claimed product

Art Unit: 1302

but rather, to teach that chewing gums are commonly produced in unlimited designs using various shapes and colors. It would have been obvious to one of ordinary skill in the art to modify the designs disclosed by Lorenz to produce the smaller masses in the shape of bits because various designs are shown to be equivalent in Lorenz.

Appellants argue that apparatus and method of Lorenz (which is not relied upon in rejecting the claims) are not capable of producing the claimed product. In answering this argument it is asserted that by merely intermittently injecting separate and distinct masses into the extruder, the some of the claimed chewing gum designs can be manufactured. Further, while Lorenz relies on an extruder, it is considered that one at home with the use of two different confections could produce all of the claimed designs (most of which are embodied in non-elected claims) by merely using a rolling pin and a knife.

It would have been obvious to one of ordinary skill in the art to modify the design of a second mass imbedded in a first mass of a chewing gum to be in an undulating pattern (the elected species) since those in the art are fully aware that consumers take pleasure in consuming confections of various designs.

Lorenz does not teach the use of multiple flavors but merely multiple colors. For the same reason that consumers desire multi colored confections they would also desire multi-flavored

Art Unit: 1302

confections and it would have been obvious to one of ordinary skill in the art to modify the extruded gums of Lorenz to include multiple flavors since Lorenz teaches the well known concept of producing gums having multiple designs using multiple colors and to add a different flavorant to each different color is a choice that is routinely made by one in the confectionery art to optimize the desirability of the final confection.

While Lorenz does not teach the several process steps as claimed (Claims 15 et al.) these limitations are not considered because the product is obvious no matter how it is produced and merely because a process for producing an article might be patentable does not endow the article with patentability without a showing of some unexpected results. While motivation to make the article by non-elected claimed process is not shown, the motivation to make the article by another method is shown. The Examiner relies on *In re Thorpe*, 227 U.S.P.Q. 964 (Fed. Cir. 1985), wherein the court held that

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art the claim is unpatentable even though the prior product was made by a different process.

Alternatively, Cherukuri et al. disclose a multi-layered chewing gum composition composed of "at least two combined

Art Unit: 1302

compositions having different base constituents" (col. 2, lines 7 to 12.) The gum layers are "laminated together by conventional methods, e.g., co-extrusion, roller pressing, etc." (col. 2, lines 32 to 33.) The inventors contemplate using a clear wrapping for their product so that "the consumer is able to observe the multi-color designs and color variations in the compositions of this invention. The chewing gum composition contains flavors in the different layers which "may be the same or different and the amounts may be the same or different" (col. 3, lines 57 to 60.)

Table III, in col. 11 of the specification, shows the combination of colors which are contemplated by the invention. From the teaching, cited above, since a multi-color design is viewable by the consumer then it is apparent that one of the layers is larger than the other layer thereby allowing the viewing of at least two colors.

Even if Cherukuri et al. does not explicitly show the various forms which the final chewing gum can have then it is considered that it would have been obvious to one of ordinary skill in the art to vary the designs of the chewing gum products of Cherukuri et al. as done by Lorenz to make the product more attractive to the consumer because it is known in the chewing gum art to mix two gums together in attractive patterns.

Art Unit: 1302

(11) Response to argument

Appellants argue that the process of producing the claimed article is not anticipated or obviated by the prior art. As discussed above, this argument is not persuasive because the article would have been obvious regardless of how it was produced. As held in *Eskimo Pie Corp. v. John Levous and Purity Ice Cream Co.*, 3 U.S.P.Q. 23 (1929), "[t]here is no invention in merely changing the shape or form of an article without changing its function except in a design patent."

It is noted again that Appellants seem to assert that the design of the instant product provides for "the necessary structural integrity." (Page 16). While this evidence is of the proper nature to overcome the above rejections, it is considered that its presentation is improper because the evidence has no antecedent basis in the application. Further, it is considered that this evidence is not inherently disclosed in the specification because no reference is made to what type of structural integrity a mass of chewing gum requires. Lastly, and most importantly, the claims contain no language directed to the gum's "structural integrity" and therefore the Examiner is unpersuaded by this evidence.

Appellants argue that the references do not enable one in the confection art to make the claimed products. As previously stated, the reference was cited merely to disclose the

Art Unit: 1302

obviousness of the product and the motivation. It is considered that the skill required to produce the instant products is well within the skill of one of ordinary skill. As previously mentioned, the apparatus of Lorenz or one's two hands, a rolling pin and a knife are all that are required to produce the instant products. The act of imbedding is not a highly technical feat as Appellants assert.

On this last point, Appellants desire the Examiner to produce evidence of one of ordinary skill in the art. Based on both of the cited patents above, it is clear that the skill of those in the confection art is high indeed. Lorenz relies on a highly sophisticated extruder while Cherukuri et al. rely on braiding and rolling machines or a co-extruder.

Appellants refer to a statement by the Examiner where he stated that the disclosed chewing gums could be modified simply by judiciously cutting the gums with a knife. Examiner stands by this statement and further explains that by taking the fifth generally sheeted confection and cutting it horizontally just below the top imbedded mass that you would indeed produce an article that contained a second mass embedded in a first mass whereby no other mass could be seen from the bottom. Further, the extrusion process of Lorenz could be modified by merely extruding only one second mass so that the fifth gum would only have second mass on its top surface.

Art Unit: 1302

Appellants also discuss the applicability of the well known BEECHNUT® striped chewing gum as prior art. The Examiner mentioned this piece of admitted prior art only to provide another well known example of an obvious design choice.

It seems that Appellants desire legal support for the assertion that if the prior art does not disclose the specifically claimed design then a utility patent should be forthcoming. It is considered that this is inconsistent with established patent law. For support, the Examiner relies on *In re Dailey*, 357 F.2d 669, 149 U.S.P.Q. 47 (CCPA 1966), where the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.

It is finally noted, that with respect to the prosecution of a design patent that differences between a claimed design and the prior art may comprise those of surface indicia or of shape or form of the article of manufacture embodying the design and that whether any particular ornamentation is embossed on or impressed in the surface to which it is applied is considered a matter of choice well within the skill of the ordinary designer. See 109 U.S.P.Q. 57 (CCPA 1956). It is therefore considered that, in the

Art Unit: 1302

absence of some unexpected result, that Appellants are merely modifying preexisting designs, which would have been obvious.

Finally, the relevant statute for design patents, i.e., 35 U.S.C. 171 Patents for designs, states that:

Whoever invents any new original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

In M.P.E.P. 1502.01, it is stated that

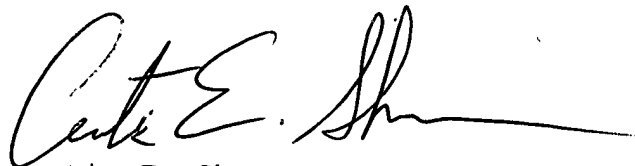
a "utility patent" protects the way an article is used and works (35 U.S.C. 101) while a "design patent" protects the way an article looks (35 U.S.C. 171. The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance."

The "utility" of Appellants' article is that it is a confection.

The "invention" of applicants' article is in its design.

Appellants have provided no evidence to the contrary.

For the above reasons, it is believed that the rejections should be sustained.



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Respectfully submitted,



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